Our Reference: MNI-100-TM TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	M & N Plastics
Serial Number:	76/182,175
Filing Date:	December 8, 2000
International Class Number:	020
Examining Attorney/Law Office:	Brian J. Pino/113
Mark:	JOE COOL

APPLICANT'S APPEAL BRIEF

Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

This is an Appeal of the Examiner's refusal to register Applicant's mark as he believes the mark as used on the goods is "ornamental." The Applicant respectfully disagrees with the position of the Examiner and submits its mark is definitely an indicator of source on the goods, rather than mere ornamentation.

There appears to be no clearly defined rule for determining whether a mark applied to goods is ornamental versus an indicator of source. It is clear that incidental ornamentation is not a bar to registration. Keene Corporation v. Paraflex Industries, Inc., 653 F. 2d 822, 211 USPQ 201. Accordingly, one must look to classic characteristic of true trademarks. They include:

(a) the appearance of the mark on the goods;

(b) the exclusion of other marks on the same goods;

(c) the fact that the mark can be spoken and written and, therefore, used to call for, or designate, the goods in a purchase transaction; and

(d) distinctiveness as to particular goods.

Here Applicant's mark satisfies every test and evidence has been submitted to show this. The Examiner's position is highly, if not exclusively, subjective and unsupported by either evidence or case law. Under these circumstances, Applicant must enjoy the benefit of the doubt.

The goods of the Applicant are plastic sleeves providing thermal protection to users of hot drink cups. The Applicant has made its goods out of a clear plastic material to allow the designs and colors of the underlying cup to show through. The mark on the sleeve does not "compete" with the design or color on the underlying cup, but nevertheless can be seen and recognized as an indicator of source.

The Applicant did not place mark in small letters on the flat lip or bottom rim as Examiner suggests because the Applicant did not believe the mark would be visible to the purchasers in that small space on clear plastic. The location and size selected was purely a marking of the goods to clearly indicate source.

The Applicant is selling its goods to retail establishments to place over their cups. These JOE COOL clear thermal sleeves will allow the design/marks of the purchaser to be visible when the goods are utilized in the marketplace (i.e., placed on cups at STARBUCKS, McDONALD'S, EINSTEINS, etc.).

With its response to the Office Action dated June 18, 2002, the Applicant submitted two samples of promotional advertisements of its goods (attached hereto as Exhibits A

and B) which promotes the goods and the clear see-through nature of the JOE COOL insulated sleeves. The attachments submitted do support the fact that Applicant's mark on its see-through sleeves is not ornamentation but a mark which can be spoken and written and used in purchase transactions like other marks. Exhibit A even notes that printing (or design) is not part of the process and Exhibit B displays the stylized form of the mark that appears on the sleeves.

Most of the cases dealing with the ornamentation issue have involved symbols on clothing, primarily shirts, which notoriously bear tags with the manufacturer's name and/or primary mark. For example, the mark SUMO on T-shirts was found to be ornamental in In re Dimitri's, Inc., 9 USPQ 2d 1666 (TTAB 1988). The reason was because it appeared with stylized representations of sumo wrestlers and was viewed as part of the thematic whole decoration of the shirts and hats.

The same situation existed in In re Astro-Gods Inc., 223 USPQ 621 (TTAB 1984) where the term ASTRO GODS appeared with a design legend depicting the gods on the front of a shirt. This was deemed ornamentation.

There have been instances where the Board has determined that a mark on the front of a shirt/hat is not mere ornamentation because it is an identifier of a secondary source. See In re Olin Corporation, 181 USPQ 182 (TTAB 1973), In re Paramount Pictures Corporation, 213 USPQ 1111 (TTAB 1973), and In re Watkins Glen International, Inc., 227 USPQ 727 (TTAB 1985). In these cases, the purchasing public had another contact with the mark used and would not therefore view it primarily as decoration on a shirt.

The Applicant submits its mark will not reasonably be viewed as a decoration either. As stated in McCarthy on Trademarks, 7:24, pages 7 - 62:

> "If customers perceive a design only as pleasing ornamentation, then the design is not a trademark. If customers perceive a design as not only attractive, but as an indicator of source, then it is a trademark. The issue is not one of a public policy against 'aesthetic functionality' but one of public perception."

The Examiner has no evidentiary support for the proposition that Applicant's mark is only pleasing ornamentation. The mark is stylized, but marks on goods, boxes, tags, etc. are often used in stylized font. The mark is not colored to make it decorative nor is any design, such as a JOE COOL character, utilized to make it ornamental or more noticeable. It is not the same as a symbol or slogan emblazoned across the front on a T-shirt. The mark is unique as to thermal sleeves for hot drink cups and there is no other indicator of source on the sleeves. It has every common characteristic of a true trademark. It goes without saying that if JOE COOL were used on goods from another manufacturer, there would be classic confusion. Therefore, this is not an ornamentation of the goods as it will only be really seen and/or noticed at purchase or prior to use.

The evidence of use of "JOE COOL" attached by the Examiner supports Applicant's position that the term JOE COOL on its goods will be perceived as a trademark. There may be a character popularized by Charles Schultz but there are also other examples cited such as JOE COOL thumb splints and gloves, JOE COOL online games; JOE COOL band; and JOE COOL treats. The term JOE COOL can be used as a source identifier for many different things. Here the mark actually has a double meaning; i.e., it is not only a slang term for a chic person, it also suggests the function of the goods in providing protection from hot contacts. Again, this is a classic trademark indicator.

The mark was not placed on the goods to make the goods more attractive or pleasing in appearance. It is on the goods in a stylized manner as this is the way the Applicant is currently using its mark. There is no design nor is the mark colored or enhanced. It is just stamped into the plastic of the goods. This is unlike the situation in In re Villeroy & Boch S.A.R.L, 5 USPQ 2nd 1451 (TTAB 1987) where the Board agreed with the Examiner that floral designs on dishes are ornamental and not initially source identifying. Moreover, floral designs are not speakable terms, a decided disadvantage as far as trademarks are concerned. The purchaser would look at the flower design as pleasing ornamentation and not as a source identifier. The Applicant submits its mark on its sleeves is not "pleasing ornamentation." It identifies the source of the goods.

The Trademark Act does not bar registration of marks which may be ornamental, but which also indicates origin. The Applicant submits its mark JOE COOL, as it appears on its goods, bears every characteristic of an indication of source and would not be viewed by the purchasing public as merely ornamentation. A refusal of registration may actually promote confusion in the marketplace. Therefore, the Applicant respectfully requests the Board allow registration of its mark.

Respectfully submitted,

YOUNG & BASILE, P.C.

Thomas N. Young
Attorney for Applicant(s)
Registration No. 20,985
(248) 649-3333
3001 West Big Beaver Rd., Suite 624
Troy, Michigan 48084-3107
Dated: June 30, 2003
TNY/KGM/dge

the fee submitted will be applied to the classes in ascending order, beginning with the lowest numbered class and including the number of classes in the application for which sufficient fees have been submitted. See 37 CFR 2.85(e) and 2.141, and TMEP 1113.05(a) and 1501.04.

1203 Appeal Briefs

1203.01 Form of Brief

37 CFR 2.142(b)(2) Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety.

A brief filed in an ex parte appeal to the Board should conform to the requirements of 37 CFR 2.142(b)(2). Only one copy of the brief need be submitted.

The brief should bear a title indicating that it is an appeal brief, as well as information identifying the application in which it is filed, namely, the applicant's name, the serial number and filing date of the application, and the mark sought to be registered. Cf. TMEP 702.

For further information concerning the form and contents of the Trademark Examining Attorney's appeal brief, in particular, see TMEP 1501.02.

1203.02 Time for Filing Brief

1203.02(a) Applicant's Main Brief

37 CFR 2.142(b)(1) The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examiner shall, within sixty days after the brief of appellant is sent to the examiner, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.

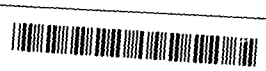
An applicant's main brief in an ex parte appeal to the Board must be filed within 60 days from the date of appeal, or within an extension of time for that purpose. If no brief is filed, the appeal will be dismissed. See 37 CFR 2.142(b)(1). If the brief is filed late, applicant will be allowed an opportunity to submit an explanation for the late filing; in the absence of an adequate explanation, the appeal will be dismissed.

If a notice of appeal (accompanied by the required fee) is filed with a certificate of mailing by first-class mail pursuant to 37 CFR 1.8, the date of mailing specified in the certificate will be used for determining the timeliness of the notice of appeal. However, the actual date of receipt of the notice of appeal in the PTO will be used for all other purposes, including the running of the time for filing applicant's main brief. See 37 CFR 1.8(a).

Our Reference: MNI-100-TM TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	M & N Plastics
Serial Number:	76/182,175
Filing Date:	December 8, 2000
International Class Number:	020
Examining Attorney/Law Office:	Brian J. Pino/113
Mark:	JOE COOL



07-03-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #2

COMMUNICATION TO BOARD REGARDING APPLICANT'S APPEAL BRIEF

Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sirs:

The Applicant, by and through its attorneys, filed an Appeal of the Examiner's refusal to register Applicant's mark on May 2, 2003.

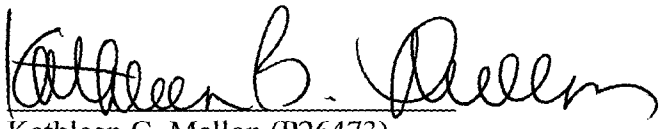
Applicant's Appeal Brief was due July 1, 2003. On June 30, 2003, the Applicant's attorney sent its brief to the Board. One copy was sent pursuant to TMBP 1203.01 (copy attached).

Applicant's attorney contacted the Trademark Board on July 1, 2003 to make certain only one copy was required. The individual answering the telephone indicated three copies were needed. The attorney asked where this was stated in the rules and the individual replied she did not know but the Board wanted three copies.

Accordingly, the Applicant's attorneys are sending herewith three copies of Applicant's Appeal Brief. These are timely as the due date is July 1, 2003.

If there are any questions regarding this, please contact the undersigned attorney.

Respectfully submitted,



Kathleen G. Mellon (P26473)
Attorney and Authorized Agent of Applicant

YOUNG & BASILE, P.C.
3001 W. Big Beaver Rd., Ste. 624
Troy, MI 48084-3107
Telephone: 248-649-3333
Facsimile: 248-649-3338

KGM/dge

TTAB

Our Reference: MNI-100-TM TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	M & N Plastics
Serial Number:	76/182,175
Filing Date:	December 8, 2000
International Class Number:	020
Examining Attorney/Law Office:	Brian J. Pino/113
Mark:	JOE COOL

07-03-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

CERTIFICATE OF MAILING AND TRANSMITTAL

Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Transmitted herewith is a postcard; a Communication to Board Regarding Applicant's Appeal Brief; three (3) copies of rule TMBP 1203.01; three (3) copies of Applicant's Appeal Brief; and three (3) copies of Exhibits A and B in the above-identified trademark application.

X No additional fee is required.
X Please charge any additional fees or credit overpayment to Deposit Account Number 25-0115.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Attn: Box TTAB, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Va. 22202-3513, on **July 1, 2003**.

Respectfully submitted,

Kathleen G. Mellon (P26473)
Attorney and Authorized Agent of Applicant

YOUNG & BASILE, P.C.
3001 W. Big Beaver Rd., Ste. 624
Troy, MI 48084-3107
Telephone: 248-649-3333
Facsimile: 248-649-3338
KGM/dge

EXHIBIT
tabbies
A

JOE COOL™ IS INVISIBLE

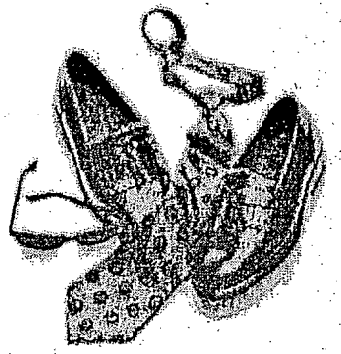
The carefully developed graphics on your cups reflect the image you've created. It's what you say about yourself to your customer. We want to help you speak clearly.

Joe Cool insulated sleeves are clear, so your image is on display, not the sleeve. Graphics you've created can even be embossed on the sleeve to enhance that image.

And Joe Cool provides exceptional insulation from the hot beverages you serve. In fact, heat from the beverage makes it form to the cup for a firmer, safer grip.

Joe is environmentally responsible too!

Joe Cool sleeves are recyclable where facilities exist. Joe Cool doesn't weaken when wet either, so it's more likely to get re-used. Manufacturing Joe Cool doesn't use harsh solvents, chemicals, inks and bleaches like most printed products, and virtually no waste is generated by the process. And because printing isn't part of the process, an entire energy consuming production step is eliminated. Now that's cool.



Don't look now, here comes Joe Cool.

Joe Cool.

Connect with Joe at 1-866-4-JOECOOL or www.joecool-online.com